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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,582	12/20/2001	Patrick Soon-Shiong	VIVOR1420-1 (073799-1107)	6249
30542	7590	06/15/2004	EXAMINER	
FOLEY & LARDNER P.O. BOX 80278 SAN DIEGO, CA 92138-0278			JONES, DAMERON LEVEST	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/029,582

**Applicant(s)**

SOON-SHIONG ET AL.

**Examiner**

D. L. Jones

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2004 and 07 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 39-64 is/are pending in the application.
- 4a) Of the above claim(s) 1-6, 39-52 and 54-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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## **ACKNOWLEDGMENTS**

1. The Examiner acknowledges the acceptable RCE filed 5/7/04. In addition, the Examiner acknowledges the amendment filed 4/7/04 wherein the claims may be summarized as follows: claims 1-6, 39-52, 54, and 64 are withdrawn; claims 7-38 are canceled; and claim 53 is amended.

**Note:** Claims 1-6 and 39-64 are pending.

## **RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENTS**

2. Applicant's arguments and amendment filed 4/7/04 to the rejection of claim 53 made by the Examiner under 35 USC 103(a) have been fully considered and deemed non-persuasive for the reasons set forth below.

### **103 Rejection**

The rejection of claim 53 under 35 USC 103(a) as being unpatentable over Dionne et al (US Patent No. 5,874,099) is MAINTAINED.

Applicant asserts that the amended claim is distinguished over the cited prior art because the prior art neither anticipates nor renders obvious a core and outer layer that are non-ionically crosslinked.

Applicant's argument is found non-persuasive because in column 15, lines 39-44, Dionne et al disclose that the core and external jacket (i.e., outer layer) form an interface that is free of ionic bonding between oppositely charged polymers and free and intermediate layer of the type used in prior art microcapsules. Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

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generate a microcapsule as set forth by Applicant wherein neither the core nor the outer layer is ionically crosslinked.

### **WITHDRAWN CLAIMS**

3. Claims 1-6, 39-52, and 54-64 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b) for reasons of record in the office action mailed 4/21/03.

### **COMMENTS/NOTES**


4. It is duly noted that in Applicant response filed 4/7/04, it was stated that claim 53 is composed of at least one biocompatible gellable material which has a core containing at least one cell aggregate therein which is not ionically crosslinked; and an outer layer which is covalently crosslinked or both covalently crosslinked and polyionically crosslinked, but is not ionically crosslinked. However, in claim 53, the limitation that the microcapsule is composed of at least one biocompatible gellable material is not in the claim.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
D. L. Jones  
Primary Examiner  
Art Unit 1616

June 10, 2004